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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,653

04/22/2004

Masafumi Hizukuri

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7014

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7590

05/10/2006

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EXAMINER

JOHNSON, JONATHAN J

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/829,653	Applicant(s) HIZUKURI ET AL.	
	Examiner Jonathan Johnson	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 4,8 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,3,5,6,7,9,10, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0761371 (Sato). Sato teaches a bonding tool, abutting on the object to be bonded (figure 1, item 3d); and a pressing unit, pressing the bonding tool to the object to be bonded (figure 3, item 23); wherein the bonding tool includes: a traverse elongated horn (figure 1, item 3); a vibrator, applying a longitudinal vibration to the horn in a first direction along the longitudinal direction of the horn (figure 1, item 1); a protruding part, protruding from the horn in a second direction substantially perpendicular to the first direction; a bonding operation part, provided in the end part of the protruding part to abut on the object to be bonded (figure 1, item 3); and a heating unit, inserted into a mounting hole provided in the horn (figure 1, item 6); and wherein the heating unit is mounted into the mounting hole with a space maintained from the inner surface of the mounting hole (figure 1, item 3e); wherein the vent part is a traverse elongated slit in the first direction (figure 1, hole at item 7); where a vent part is provided for preventing the transfer of heat to the vibrator in the horn between the vibrator and the bonding operation part (opening at item 6); a traverse elongated horn (figure 1, item 3); a vibrator, applying a longitudinal vibration to the horn in a first direction along the longitudinal direction of the horn (figure 1, item 1); a

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protruding part, protruding from the horn in a second direction substantially perpendicular to the first direction (figure 1, item 3); a bonding operation part, provided in the end part of the protruding part to abut on the object to be bonded (figure 1, item 3); and a rod shaped heating unit, inserted into a mounting hole provided in the horn; wherein the heating unit is mounted into the mounting hole with a space maintained from the inner surface of the mounting hole (figure 1, item 6); wherein a vent part is provided for preventing the transfer of heat to the vibrator in the horn between the vibrator and the bonding operation part (opening at item 6);

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an open space maintained from the heating unit to the inner surface of the mounted hole) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues Sato does not teach a space maintained from the inner surface of the mounting hole as required by claim 1. The examiner disagrees. During patent examination, the pending claims must be "given the broadest reasonable interpretation." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the instant case, Sato teaches that the heating unit has a metal case (col. 4, ll. 18-19). In applying the

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Prater test by giving the claims its broadest reasonable interpretation, it is the examiner's position that when the heating unit is inserted into the mounting hole, the space taken up by the metal case satisfies the claim limitation.

Applicant next argues that Sato does not teach the claim 9 limitation of a rod shaped heating unit inserted into the first direction of the horn. The examiner disagrees. In Sato's figure 1, the horn vibrates in the first direction of the x-y axis and the protruding part protrudes in the second direction of the z-axis. The rod-shaped heating unit is shown to be inserted in the x-y axis, which corresponds to the first direction.

Applicant next argues that there is no vent part because Sato teaches the heater's end is closed. The examiner disagrees with applicant's characterization of Sato. While Sato teaches the end can be closed, Sato also explains that the heater holes can be open (col. 4, l. 36).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177.

The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jonathan Johnson
Primary Examiner
Art Unit 1725